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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,158	05/29/2001	Akira Wakabayashi	892_017	5962
25191	7590	09/15/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			GARG, YOGESH C	
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DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/867,158	Applicant(s) WAKABAYASHI ET AL	
	Examiner Yogesh C Garg	Art Unit 3625	<i>KLW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-S48) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/27/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

1.1. Claimed Invention(s) does not fall within the Technological Art.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and

"abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to

determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analyses go towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, **State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).**

In the present application, Claims 1-9 have no connection to the technological arts. None of the steps indicates any connection to a computer or technology. The system's storage unit for containing information, input device, search unit, output unit and the method steps of inputting information, storing the information, outputting information, searching information, displaying information, and transmitting purchase information could be performed manually by people. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify if the system units and manipulative steps are being performed within the technological arts, such as

incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeland (US Publication Number 2002/0169640 A1).

Regarding claim 1, Freeland teaches a car sale information providing system comprising:

a car information storage unit stored with mappings of car information containing a name, a type, a year model etc of a car to car inspection information obtained as a result of inspecting the car concerned (see at least Paragraph 0007, pg.1, " *in accordance with the present invention, assist the seller in building a web site for their vehicle that will provide the buyer with information and products to make a confident purchase. The agent will also perform or arrange for a reconditioning inspection of the item (e.g., a car) to give suggestions for the seller to perform prior to displaying their item. Digital pictures of the item may be taken and loaded on the site as well as scanned maintenance records and attaching a vehicle title history.* ", and paragraph 0036, pg.3, "... the system agent will either perform or arrange for a non-certified body and interior inspection 23, as shown in FIG. 2. **This inspection will result in a report (see the right side of FIG. 2) with form sections for the seller's personal information 24, general vehicle information 25, description of vehicle options 26, and evaluations of: 1) the overall condition of the body of the vehicle 27 (and each separate body panel); 2) the interior 28 (e.g., front and rear carpet and seats); 3) mechanical elements 29 (e.g., engine, transmission, air-conditioning, heating, brakes, exhaust, etc.); and 4) tires 30.** "Note: The Title history information and the Inspection reports will inherently include car information, such as including a name, a type, a year model etc. All this information is stored at the web site created for selling the car and the web site would include a storage device to store the said information about the car.)

a car information input device inputting the car information and getting the car information stored in said car information storage unit (see at least pg.6, ".....**REPORT NAME DESCRIPTION Vehicle Inspection Checklist given to certified mechanic. Report is returned to agent where results are input into the system. Title Report Printable version of vehicle's Title search results.** " ;

a search unit outputting an input screen to input conditions when searching the car information stored in said car information storage unit, and searching based on conditions

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inputted (see at least pg.5, paragraphs 0061—0064, “ *Potential used auto buyers will access the inventory and decide to purchase services for a specific listed vehicle. Buyers may opt to buy fee-based services throughout the used vehicle purchasing process or before deciding on a specific vehicle. The components of this system may include: **Vehicle Searching****Financing****Title Searching*** “ ; and

a car information output unit outputting display information, including a purchase indication interface transmitting car purchase information containing the searched car information and the car inspection information corresponding to the car information (see at least paragraphs 059-0069, pg. 5, “ ***Results may be readily displayed on a computer available to the system agent.When a seller agrees to transfer a vehicle to a prospective buyer, the two parties begin negotiation, and eventually agree on purchase price and repairs to be made. If the system is implemented using a website, a standard, read-only status report may be used. It may, for example, display the seller's requirements and target date of completion of the sale. It may also inform the seller about documentation which needs to be submitted before the process can continue. This status report and will be controlled and edited by the system agent. The results of the account management process are available for review by the buyer.Potential used auto buyers will access the inventory and decide to purchase services for a specific listed vehicle. Buyers may opt to buy fee-based services throughout the used vehicle purchasing process or before deciding on a specific vehicle. The components of this system may include: “).***

Regarding claims 2, Freeland as applied to claim 1 discloses a car sale information providing system according to claim 1, further comprising an inspection indication output unit for outputting inspection indicative information for prompting an inspection of an uninspected car corresponding to the input of said car information input device (see at least paragraph 0082, page 6, “ *Workflow reports [automated and manual] may include printable reports..Sytem agent prints*

*an inspection report.....,”. Note: Printer corresponds to the output unit which prints the inspection report), wherein said car information input device gets the car information of the uninspected car stored in said car information storage unit in a state where the same car information is not searchable by said search unit ((see at least paragraph 0082, page 6, “Workflow reports [automated and manual] may include printable reports..Sytem agent prints an inspection report.....,”. Note: the received printed report received by the device is not in a searchable state as it is still not stored in a digitized state), and said car information storage unit changes the car information to a searchable state in accordance with an input of the car inspection information created from the inspection based on the inspection indicative information (see at least paragraph 0042, page 4, “, the seller or buyer can purchase a vehicle inspection, which may be performed by the agent or by a certified sub-contractor, e.g., a local certified mechanic. The inspection form is given to a certified mechanic to complete. Forms may be pre-printed or printable from a website available to the agent or his subcontractor. **The mechanic then returns the completed inspection to the system agent and the system agent enters the inspection results into the system. Alternatively, the agent may scan the report to create electronic version of the inspection report. Preferably, once inspection has been completed, either the seller, buyer, or a member of the agent's staff can view or print the vehicle inspection report at any time.** “.. Note: The input or scanned report in electronic form is searchable.).*

3.2. Regarding claims 3-5, their limitations are closely parallel to the limitations of claims 1-2 and are therefore analyzed and rejected on the same basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4.1. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeland and further in view of Merrick et al. (US Patent 6,433,784); hereinafter referred to as Merrick.

Regarding claims 6-9 all the limitations are already covered in claims 1-5 as analyzed above and anticipated by Freeland except for storing and exhibiting automobile information in animated image data or sound data. However, Merrick in the same field of endeavor teaches storing and exhibiting automobile information in animated image data or sound data (see at least , col.2, lines 18-31, “ *in the case of a web site for the sale of automobiles, a user might click on the graphic of the particular model that interests him or her resulting in the display of a web page completely dedicated to that model. That page may also include the dynamic animation (often including dialog) representing the company's mascot welcoming the user to the page concerning the particular model. Additionally, the advantages of the real time interaction may be effected such that the character, for example, describes and points to various features of the car based upon user input (e.g. the user points to a portion of the automobile graphic which is of interest).*

“). In view of Merrick, it would have been obvious for one of an ordinary skill in the art at the time of the applicant's invention to have modified Freeland to incorporate the feature of storing and exhibiting automobile information in animated image data or sound data because display of animated data for a product stimulates the feelings of the viewers resulting in more active and effective participation of the viewers in the displayed exhibit.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US2002/0032626 A1 to DeWolf et al. discloses inputting and storing automobile data/information in a storage device, called a Global Asset Information Registry [GAIR], by sellers/manufacturers and providing access to this data to anybody who have an interest in the stored assets (see at least abstract and paragraphs 0029-0055, pg.2-5).

(ii) US Patent 5,459,304 to Eisenmann discloses a car information storage unit storing information like car's type, name, a year model, etc., a search unit for searching input information, an outputting display (see at least abstract).


(iii) Press release, “ Research pays off in auto purchase Internet, classifieds reliable resources; Bangor Daily news; Bangor, Me; Mar 22, 1999; pg.1, extracted on Internet from Proquest database on 9/10/2004 teaches storage units storing information about used cars .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 10, 2004